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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,365	12/20/2001	William Henry Harrison	13DV13906	4330

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EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

008

**Office Action Summary**

Application No.

10/029,365

Applicant(s)

HARRISON ET AL.

Examiner

John P. Sheehan

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Substitute Specification***

1. Applicants are advised that the substitute specification submitted September 15, 2003 has been entered.

2.

### ***Claim 21***

3. In their response applicants note that there is no claim 21 in the application (see applicants' response submitted September 15, 2003, page 14, second full paragraph). Applicants' attention is directed to the Preliminary Amendment submitted December 27, 2002 (page 2) where claim 21 is added as a new claim.

### ***Specification***

4. The amendment filed September 15, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

I. Amended paragraph 22, is drawn to new matter. In paragraph 0022 applicants have changed Inconel 907 to INCOLOY ® 907. Applicants have cited original claim 13 as support for this amendment (applicants' response, page 12, last paragraph). The Examiner does not agree. Original claim 13 and original paragraph 0022 of the

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specification are inconsistent with each other. Thus, an error appears to exist.

Although it is obvious that there is an error, that either original claim 13 or original paragraph 0022 is incorrect, it is not obvious that original paragraph 0022 is, in fact, wrong. In view of this the amendment to paragraph 0022 is considered to be new matter, MPEP 2163.07.

II. In like manner, amended paragraph 23 is drawn to new matter. In paragraph 0023 applicants have changed Inconel 909 to INCOLOY ® 909. Applicants have cited original claim 16 as support for this amendment (applicants' response, page 12, last paragraph). The Examiner does not agree. Original claim 16 and original paragraph 0023 of the specification are inconsistent with each other. Thus, an error appears to exist. Although it is obvious that there is an error, that either original claim 16 or original paragraph 0023 is incorrect, it is not obvious that original paragraph 0023 is, in fact, wrong. In view of this the amendment to paragraph 0023 is considered to be new matter, MPEP 2163.07.

III. In like manner, amended paragraph 24 is drawn to new matter. In paragraph 0023 applicants have changed Inconel 903 to INCOLOY ® 903. Applicants have cited original claim 10 as support for this amendment (applicants' response, page 13, lines 1 to 4). The Examiner does not agree. Original claim 10 and original paragraph 0024 of the specification are inconsistent with each other. Thus, an error appears to exist. Although it is obvious that there is an error, that either original claim 10 or original paragraph 0024 is incorrect, it is not obvious that original paragraph 0024 is, in fact,

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wrong. In view of this the amendment to paragraph 0023 is considered to be new matter, MPEP 2163.07.

IV. Amended paragraphs 0003, 0014, 0021, 0022, 0023 and 0024 are drawn to new matter. Each of these paragraphs has been amended to include the specific compositions for one or more of INCONEL ® 718, Waspaloy <sup>TM</sup>, RENE®-41, INCOLOY® 903, INCOLOY® 907 and INCOLOY® 909. Applicants indicate that these are well known alloys with known specific compositions and therefore the addition of the specific alloy compositions to the specification is not new matter. The Examiner does not agree. Applicants have not provided any evidence to support their allegation that INCONEL ® 718, Waspaloy <sup>TM</sup>, RENE®-41, INCOLOY® 903, INCOLOY® 907 and INCOLOY® 909 are each well known alloys known to possess the specific compositions inserted into paragraphs 0003, 0014, 0021, 0022, 0023 and 0024.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 2, 4 to 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

I. The claims have been amended to include the specific compositions for INCONEL ® 718, Waspaloy <sup>TM</sup>, RENE®-41, INCOLOY® 903, INCOLOY® 907 and INCOLOY® 909. Applicants indicate that these are well known alloys with known specific compositions and therefore the addition of the specific alloy compositions to the claims is not new matter. The Examiner does not agree. Applicants have not provided any evidence to support their allegation that INCONEL ® 718, Waspaloy <sup>TM</sup>, RENE®-41, INCOLOY® 903, INCOLOY® 907 and INCOLOY® 909 are each well known alloys known to possess the specific compositions inserted into the claims.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps